

**REMARKS**

By this Amendment, Applicants amend claims 1-3, 6-10, 12, 16, and 17, and add claims 18 and 19. Thus, claims 1-19 are pending in this application. No new matter is added. Applicants respectfully request reconsideration of the application in light of at least the following remarks.

Applicants appreciate the courtesies shown to Applicants' representative by Examiners Ries and Shah during the February 8 personal interview. Applicants incorporate a separate record of the substance of the interview into the following remarks.

The Office Action Rejects claims 1-7 and 9-16 under 35 U.S.C. §103(a) over Price, et al., "Linking by Inking: Trailblazing in a Paper-Like Hypertext" (hereinafter "Price") in view of Golovchinsky, et al., "From Reading to Retrieval: Freeform Ink Annotations as Queries" (hereinafter "Golovchinsky"). Applicants respectfully traverse the rejection.

As discussed during the personal interview, neither Price nor Golovchinsky disclose, teach, or suggest that "each of the at least two documents are pre-selected by a user of the system," as recited in claims 1 and 9. Both Price and Golovchinsky disclose systems and methods wherein a source document is annotated (Price pp. 33 and 34; Golovchinsky pp.19-22). Each annotation is converted into a query and a database is searched for other documents related to the query (Id). Importantly, each document that is returned by the search is unknown to the user prior to the search and thus cannot be "pre-selected."

Applicants note that the above described deficiency of Price and Golovchinsky results from a fundamental difference between the objects of Price and Golovchinsky and the inventions recited in claims 1 and 9. The systems and methods of Price and Golovchinsky search for new information (see e.g., Price, "Introduction," and Golovchinsky, "The Problem"). The system of claim 1 and the method of claim 9 apply similar annotations to other known documents to aid in review and revision of those other known documents (see

e.g., page 1, lines 14-21; page 3, lines 17-32). Because the systems and methods of Price and Golovchinsky help a user search for documents within a database, those documents cannot be known to a user before the search and thus cannot be "pre-selected."

Because neither Price nor Golovchinsky disclose, teach, or suggest that "each of the at least two documents are pre-selected by a user of the system," claims 1 and 9 are patentable over the asserted combination of Price and Golovchinsky. Further, Applicants respectfully submit that claims 2-7 and 9-16 are patentable for at least the reasons that claims 1 and 9 are patentable, as well as for the additional features they recite. Applicants respectfully request withdrawal of the rejection.

The Office Action Rejects claims 8 and 17 under 35 U.S.C. §103(a) over Price and Golovchinsky in view of U.S. Patent Application 6,363,179 to Evans et al. (hereinafter "Evans"). Applicants respectfully traverse the rejection.

This rejection is premised upon the presumption that Price and Golovchinsky disclose, teach, or suggest all of the features of claims 1 and 9. Because, as discussed above, neither Price nor Golovchinsky disclose all of the features of claims 1 and 9, the rejection is improper.

Furthermore, Evans does not disclose, "using the same type of annotation," as recited in claims 8 and 17. The Office Action relies on col. 2, lines 1-14 as disclosing that highlighting is used in both a source and target document. However, that portion of Evans only discloses displaying text in a target document in a visually distinct. Evans does not discuss annotating a source document at all. In fact, in Evans, there is no indication that the query is anything more than a conventional search term query (col. 5, lines 39-44; Fig. 4(a)). Because the systems and methods of Evans only use a conventional search term query, there is no source document, and no annotated terms in the source document. Thus, Evans does not

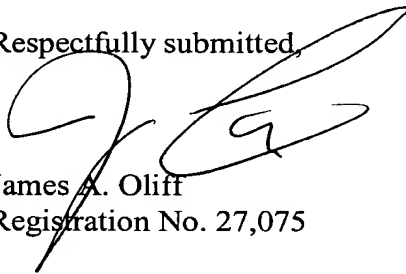
disclose, teach, or suggest using a same type of annotation in the source document and target document.

Because the rejection is improper and Evans does not disclose, "using the same type of annotation," claims 8 and 17 are patentable over the combination of Price, Golovchinsky, and Evans. Applicants respectfully request withdrawal of the rejection.

In view of at least the foregoing, Applicants respectfully submit that this application is in condition for allowance. Applicants earnestly solicit favorable reconsideration and prompt allowance of claims 1-19.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, Applicants invite the Examiner to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



James A. Oliff  
Registration No. 27,075

Jesse O. Collier  
Registration No. 53,839

JAO:JOC/tea

Date: February 10, 2005

**OLIFF & BERRIDGE, PLC**  
**P.O. Box 19928**  
**Alexandria, Virginia 22320**  
**Telephone: (703) 836-6400**

<p>DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 24-0037</p>
--